

No. 16,440

IN THE

United States Court of Appeals
For the Ninth Circuit

PATRIARCA MFG., INC., a corporation, DOMENICO
PATRIARCA, an individual, and DONALD A.
CAMERON, an individual,

Appellants,

vs.

MELVIN SOSNICK, MARVIN SOSNICK, and PETER
SOSNICK, a copartnership, doing business as
Melvin Sosnick Co., and MELVIN SOSNICK,
MARVIN SOSNICK and PETER SOSNICK, indi-
viduals, and ALFRED AUSTRUY, an individual,

Appellees.

APPELLANTS' REPLY BRIEF.

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APPELLANTS' REPLY BRIEF.

This brief is in reply to the "Brief for Appellees" filed by defendants and is submitted to refute the erroneous contentions advanced therein.

Defendants' argument is two-fold. First, they claim that plaintiffs' showcase was anticipated by the prior art and was not beyond the skill of an ordinary designer in the art. Secondly, they contend that the commercial success of plaintiffs' showcase will not supply invention when invention is clearly lacking. Neither of these contentions is supported by their argument or by the facts in the case.

I.

PLAINTIFFS' SHOWCASE IS NOT ANTICIPATED BY THE PRIOR ART AND IS BEYOND THE SKILL OF AN ORDINARY DESIGNER.

Defendants begin their argument against this proposition by citing various cases which set forth the general ground rules for design patent cases. There is no quarrel here, since plaintiffs rely upon the most recent Ninth Circuit case, *Robert W. Brown & Co. v. De Bell*, 243 F.2d 200 (1957), as the controlling law on the subject.

Defendants err, however, in their application of the law of the *De Bell* case to the facts in the present controversy.

As has been brought out in our "Brief for Appellants", the most obvious visual distinction between plaintiffs' showcase and the prior art Royal showcase is in the design of the lower front panel of the cabinets. The Royal showcase has a lower front panel extending vertically down to the floor in prominent view of a prospective purchaser, which panel acts to divert his attention away from the contents of the cabinet. Plaintiffs' lower front panel instead slopes downwardly and rearwardly, away from a customer. This design causes this panel to disappear from view when seen from normal eye level with the effect that the contents on display in the cabinet are suspended out towards the customer. The design of the prior art Royal showcase sets up a barrier to sales; plaintiffs' design offers the contents to the customer and invites him to come closer and buy.

Defendants recognize this design difference in their brief wherein at page 5 they refer to this distinction between the Royal and plaintiffs' showcases. They then

go on to say that this particular feature is unimportant, relying on testimony of Mr. Patriarca apparently to that effect.

The portion of Mr. Patriarca's testimony set forth is highly misleading in the context used by defendants. Mr. Patriarca was not describing the difference between the vertical front of the Royal cabinet and the rearwardly sloping front of plaintiffs' cabinet. Instead, he was being asked about the differences between plaintiffs' showcase and a Rubinfeld showcase, both of which had lower front panels disposed rearwardly of the front of the showcase, away from a customer.

Thus, defendants are trying to use Mr. Patriarca's comparison of the lower front panels of plaintiffs' showcase and a Rubinfeld showcase to prove that there is no difference between plaintiffs' showcase and the prior art Royal showcase. However, just because a large orange looks like a small grapefruit doesn't mean that it also looks like a banana.

Instead of thinking that the design of the lower front panel was unimportant, Mr. Patriarca testified exactly to the contrary:

“Well, it has quite a few advantages. The first, it improves the symmetry, the balance, and does subdue the woodwork and bring out the display of merchandise.” (R. 86.)

Obviously, defendants' contention is erroneous.

Defendants' next contention is that the presumption of validity of plaintiffs' patent is destroyed since the prior art now relied upon was not considered by the Examiner

in the Patent Office. Defendants also assert that the Examiner never would have granted a patent on plaintiffs' showcase had he been aware of this "newly discovered" prior art.

This argument is not valid, however, unless this newly discovered prior art is, in fact, more pertinent than that actually considered by the Examiner. If not more pertinent, then the presumption of validity is undisturbed, and in fact, is strengthened.

From the Cameron patent itself, we know that the Examiner in the Patent Office had the Tyler design patent, Des. 111,868, in front of him when he decided to grant plaintiffs' patent. Now, what do the defendants consider to be even better as prior art. According to the following testimony of defendants' expert witness, Mr. Lippincot, the most pertinent prior art device found by defendants was the Rosenberg counter:

"Q. Now you have mentioned a lot of prior art devices, Mr. Lippincot. Which one patent would you say, in your opinion, and including this Exhibit A, this prior use, which one cabinet shown by those would you say most closely resembles what we have been calling this Patriarca cabinet?

A. If we are talking about the Cameron Patent on the Patriarca device, I would think that probably the Rosenberg looks as much like it as any other." (R. 188-189.)

It should be noted that Mr. Lippincot was fully considering the Royal showcase, Exhibit A, when he selected the Rosenberg counter as the most pertinent prior art device of all.

Dec. 2, 1952

D. A. CAMERON
SELF-SERVICE DISPLAY CONTAINER
Filed May 7, 1952

Des. 168,288

Oct. 25, 1938.

J. TYLER
REFRIGERATOR DISPLAY CASE
Filed June 20, 1938

Des. 111,868

(No Model.)

I. ROSENBERG.
DISPLAY ATTACHMENT FOR COUNTERS.

No. 543,657.

Patented July 30, 1895.

FIG.1

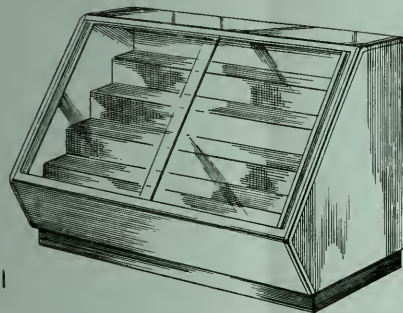


FIG.2

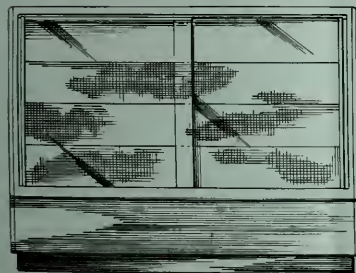
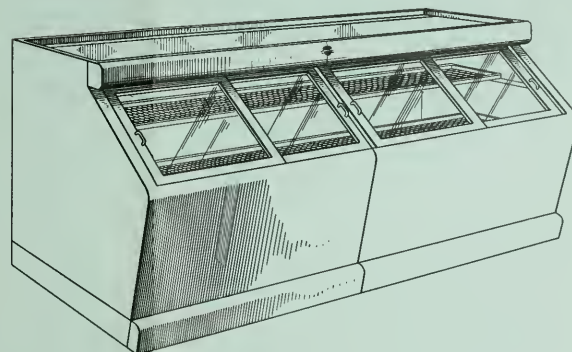


FIG.3



INVENTOR.
Donald A. Cameron
BY *Harman & Tucker*
ATTORNEY



Inventor
Jerry Tyler
BY *Lawrence and Van Antwerp*
Attorneys

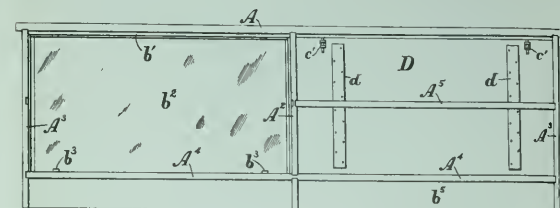


FIG. 1.

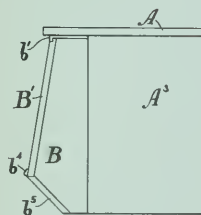


FIG. 2.

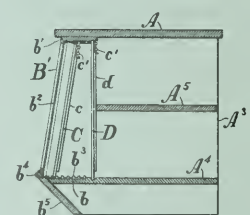


FIG. 3.

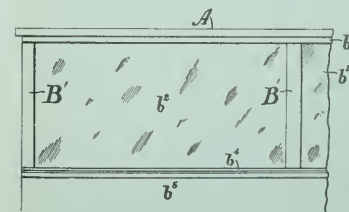


FIG. 4.

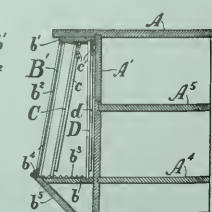


FIG. 5.

WITNESSES.
Howard H. Faltow
Emma Lyford

INVENTOR.
Isaac Rosenberg
BY *Geo. J. ...*

Since a visual inspection is worth a ream of argument, plaintiffs' patent, the Tyler prior art patent and the Rosenberg patent are illustrated on the opposite page. As is readily apparent, the old-fashioned Rosenberg counter is much farther in concept from plaintiffs' invention than is the Tyler patent considered by the Examiner. Therefore, since the most pertinent prior art has been considered by the Patent Office, then the presumption of validity has not been "destroyed".

Defendants conclude this phase of their argument by throwing stones at the Patent Office, saying that plaintiffs' patent is a "disgrace" to the patent system, that it brings discredit to the Constitutional wish of our forefathers and that plaintiffs' showcase is a "gadget" never contemplated by our Constitution or laws as patentable.

This is a great amount of opprobrium to heap upon plaintiffs' showcase which was copied "to the fraction of an inch" (R. 65) for use by the defendants. It certainly does not explain why defendants turned their backs on all of the prior art showcases freely available to them and instead selected plaintiffs' "disgraceful gadget" to sell their merchandise.

II.

THE COMMERCIAL SUCCESS OF PLAINTIFFS' SHOWCASE IN THE SALE OF CIGARS IS HIGHLY INDICATIVE OF INVENTION IN THE DESIGN THEREOF.

It should be noted that defendants have not controverted the main point raised in plaintiffs' brief, namely, that evidence of commercial success is the most important

and reliable objective test of invention of the design of a showcase. The only reason for designing a showcase is to create sales of the merchandise displayed. If there is commercial success in such sales, then the design is effective for its purpose. Instead, defendants rely on *Junger-son v. Ostley & Barton Co.*, 335 U.S. 560; *Pointer v. Six Wheel Corp.*, 172 F.2d 153, and *Application of Lange*, 228 F.2d 245, for the general proposition that commercial success is only to be considered in a close case of invention. However, all three of these cases deal with *mechanical* patents; they are not concerned with *design* patents.

Instead of challenging plaintiffs' position, defendants throw up a smoke screen to hide behind. First, they assert that defendants did not themselves copy and build the accused showcase, but instead that they bought the accused showcase from Rubinfeld Showcase Co. for resale. However, such an argument does not hide the fact that defendants freely chose to use and sell slavish copies of plaintiffs' patented showcase.

Next, defendants challenge the finding by the trial Court that the evidence clearly established commercial success of the showcase of the design patent. (Finding No. 26, R. 44.) Defendants say that this finding is based only on the testimony of Marcus Glaser, and imply that his testimony is not credible. However, the trial Court is the one best able to assess the credibility of the witness, and his finding on this point should not be disturbed unless clearly erroneous. The only real "reason" raised by defendants is that Mr. Glaser is a business competitor of theirs. More than this is necessary to decide now that Mr. Glaser's testimony is not credible. It might also be

pointed out that the trial Court was personally acquainted with Mr. Glaser and has known him for a number of years. (R. 95.) It is highly unlikely that the Court would have been clearly mistaken as to the credibility of Mr. Glaser.

Defendants then make much of their contention that they are being persecuted because plaintiffs brought suit against them to stop their infringement. The purpose of this argument, and its relation to commercial success is not at all clear. Defendants do not contend that the law requires plaintiffs to sue infringers in any specified sequence. Certainly, they cite no case or statute to that effect. Neither do defendants here deny that they have infringed plaintiffs' patent. All that they are doing is trying to disguise their infringement by pointing an accusing finger at Rubinfeld Showcase Co. and by saying that Rubinfeld is an even greater infringer. This is no ground for escaping liability.

Defendants' final contention touches upon the issue of commercial success, and is to the effect that the success of plaintiffs' showcase is due to both its design and to its ability to keep cigars fresh and moist. This argument seems to be that the success is impossible to separate between the two, and, if anything, is due entirely to the use of the humidifier (a mechanical, not a design, feature) in the cabinet.

However, the use of humidifiers in cigar showcases is not new. (Finding No. 18, R. 43.) Therefore, the commercial success of plaintiffs' showcase cannot be due to the use of this old mechanical feature used by others. Moreover, the freshness of the cigars will be apparent

only upon smoking them, and will serve only to create a desire to buy more cigars at a later time. The humidifier does not create any initial desire in a prospective customer, especially since the humidifier is hidden from view. (R. 67.) The evidence further shows that most cigar purchases are made on the spur of the moment. (R. 102.)

Only one thing then can truly account for the proven commercial success of plaintiffs' showcase in creating these point-of-sale purchases. That one thing is the inventive design of the case.

CONCLUSION.

From the above, it is clearly demonstrated that defendants' two major points and the various side issues are without merit.

It is respectfully submitted that this Court should reverse the holding below and hold plaintiffs' design patent No. Des. 168,288 to be valid and infringed by defendants.

Dated, San Francisco, California,

February 1, 1960.

Respectfully submitted,

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